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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

0103085-0515558

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on 04/28/2006

Signature

Typed or printed name

Andrew B. Ulmer

Application Number

09/829,863

Filed

04/10/2001

First Named Inventor

Mindrum, Scott G.

Art Unit

2172

Examiner

Truong, Cam YT

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 57,003☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Andrew B. Ulmer

Typed or printed name

513-369-4811

Telephone number

April 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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09/829,863

PATENTS

UNITED STATES PATENT AND TRADEMARK OFFICE

Application:	09/829,863	Examiner:	Truong, Cam Y T
Filed:	04/10/2001	Art Unit:	2172
Inventor:	Mindrum, G. Scott	Atty Ref.:	0103085 - 0515558
Title:	METHODS OF PROVIDING A REGISTRY SERVICE AND A REGISTRY SERVICE		

PRE-APPEAL BRIEF

(in accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005))

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Final Office Action dated 02/16/2006 contains clearly improper rejections based on several clear errors in facts, and it contains several omissions of essential elements needed for the *prima facie* obviousness rejections issued in the Office Action. These errors and omissions will be addressed with respect to each of the pending independent claims.

Claim 21:

Claim 21 recites “an identifier on or near the concrete memorial for the deceased person, the identifier indicating to people visiting the concrete memorial that the information related to the deceased person is available on the on-line registry service.” (The meaning of “concrete memorial,” which Applicant contends should be immediately clear from the term on its face, is that the memorial occupies physical space and has mass, as noted on p. 6 of the Amendment and Response filed 02/27/2004.) In the pending Office Action, the Examiner purported to find this element in the prior art by combining the teachings of Figure 2 of Manross (U.S. Patent No. 6,414,663) with screenshots from Legacy.com (printed 03/01/05). Figure 2 of Manross shows a headstone with a person’s name and their years of birth/death. The Legacy.com screenshots

discuss computerized memorials for deceased persons. Without admitting that the Legacy.com screenshots properly constitute prior art, Applicant submits that the combination of Manross and Legacy.com fail to meet the limitation of claim 21 recited above. Even in combination, they fail to teach or remotely suggest an identifier on or near a concrete memorial indicating that information related to the deceased person is available on an on-line registry service, as recited in claim 21. Applicant further submits that the Examiner's suggestion that a deceased person's name, as taught by the references, constitutes an identifier indicating to people that information related to the deceased person is available on an on-line registry service, is a clear error in fact. The Examiner's argument that the combined art teaches the above-quoted limitation of claim 21 therefore constitutes clear error in facts. Furthermore, because the Examiner has otherwise failed to show how this limitation is taught or suggested by the combined prior art, the Examiner has failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03.

In addition, even if the combination of Manross and Legacy.com could somehow be viewed as teaching or suggesting the limitation of claim 21 quoted above, the Examiner has clearly failed to establish a motivation to combine the teachings of those references to obtain the invention claimed in claim 21. In purporting to find a motivation to combine the teachings, the Examiner made the following statement:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Legacy's teaching of memorial submission forms indicates an on-line registry service accessible over the Internet; the Legacy service has one web page having information related to the deceased person; the last name as a [sic] identifier indicating to people visiting the deceased person may be found on the on-line registry Legacy service to Manross's system in order to allow users to visit a deceased person via Internet system efficiently [sic] and know history of deceased person quickly.

(Office Action dated 02/16/06, p. 10). This sentence is grammatically unintelligible. The unintelligibility of the statement that purports to establish motivation to combine constitutes clear error in the rejection. Furthermore, it supports Applicant's position that the Examiner has failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.01. Ultimately, the Examiner has failed to establish any motivation to provide an identifier on or near a concrete memorial indicating that information related to the deceased person is available on an on-line registry service, as claimed in claim 21, and in combination with the other limitations recited in claim 21.

Claim 36:

Claim 36 includes the limitation “visually indicating, on or near the physical memorial for the deceased person, that the on-line registry service is associated with the deceased person.” In purporting to find this limitation in the prior art, the Examiner broke this limitation into two parts: (1) visually indicating, on or near the physical memorial for the deceased person, and (2) that the on-line registry service is associated with the deceased person. The Examiner then purported to find part (1) in Figure 3 of Manross, and part (2) in Legacy.com. Applicant submits that breaking the limitation apart in such a way is impermissible and clearly erroneous. Similar to the absence of a teaching in the combined prior art of the limitation discussed above with respect to claim 21, the Examiner has failed to establish a teaching in the combined prior art of the above-quoted limitation from claim 36. In other words, even in combination, the cited references fail to teach or remotely suggest visually indicating on or near a physical memorial for a deceased person that an on-line registry service is associated with the deceased person, as recited in claim 36. The Examiner’s argument that the combination teaches this limitation constitutes clear error in facts. Furthermore, because the Examiner has otherwise failed to show how this limitation is taught or suggested by the combined prior art, the Examiner has failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03.

In addition, even if the combination of Manross and Legacy.com could somehow be viewed as teaching or suggesting the limitation of claim 36 quoted above, the Examiner has clearly failed to establish a motivation to combine the teachings of those references to obtain the invention claimed in claim 36. In purporting to find a motivation to combine the teachings, the Examiner made the following statement:

It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to apply Legacy’s teaching of establishing a payment for an on-line registry service with a subscriber, this payment is associated with the deceased person, service is associated with deceased person, providing a user access over the Internet to the on-line registry service system, displaying name and picture of deceased person on a web page in order to allow any user to access the history of deceased persons quickly via Internet system.

(Office Action dated 02/16/06, p. 14). This sentence is also grammatically unintelligible. The unintelligibility of the statement that purports to establish motivation to combine constitutes clear error in the rejection. Furthermore, it supports Applicant’s position that the Examiner has failed

to establish a *prima facie* case of obviousness in accordance with MPEP 2143.01. Ultimately, the Examiner has failed to establish any motivation to visually indicate, on or near a physical memorial for a deceased person, that an on-line registry service is associated with the deceased person, as claimed in claim 36, and in combination with the other limitations recited in claim 36.

Claim 43:

Claim 43 includes the limitation “a seal on or near the concrete memorial for said deceased person, the seal indicating to people visiting the concrete memorial in the cemetery that the biographical data related to said deceased person is available on the on-line registry service.” In purporting to find this limitation in the prior art, the Examiner broke this limitation into two parts: (1) a seal on or near the concrete memorial for said deceased person, and (2) the seal indicating to people visiting the concrete memorial in the cemetery that the biographical data related to said deceased person is available on the on-line registry service. Again, Applicant submits that breaking the limitation apart in such a way is impermissible and clearly erroneous. Even if breaking it apart in such a manner were permissible, the cited portion of Manross (Col. 3, ll. 15-45) clearly fails to show a seal. Similarly, Legacy.com clearly fails to teach or suggest a seal indicating to people visiting the concrete memorial in the cemetery that the biographical data related to said deceased person is available on the on-line registry service. Similar to the absence of a teaching in the combined prior art of the limitations discussed above with respect to claims 21 and 36, the Examiner has failed to establish a teaching in the combined prior art of the above-quoted limitation from claim 43. In other words, even in combination, the cited references fail to teach or remotely suggest a seal on or near a concrete memorial for a deceased person indicating to people visiting the concrete memorial in a cemetery that biographical data related to the deceased person is available on an on-line registry service. The Examiner’s argument that the combination teaches this limitation constitutes clear error in facts. Furthermore, because the Examiner has otherwise failed to show how this limitation is taught or suggested by the combined prior art, the Examiner has failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03.

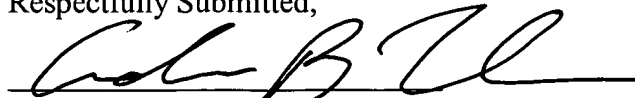
In addition, even if the combination of Manross and Legacy.com could somehow be viewed as teaching or suggesting the limitation of claim 43 quoted above, the Examiner has clearly failed to establish a motivation to combine the teachings of those references to obtain the

invention claimed in claim 43. In purporting to find a motivation to combine the teachings, the Examiner made a statement that was virtually identical to the corresponding statement made by the Examiner with respect to claim 21 (except that the word "conveniently" was substituted for the word "efficiently" – Office Action dated 02/16/2006, p. 16). Accordingly, given the grammatical unintelligibility of the Examiner's statement, the rejection of claim 43 was clearly erroneous for the same reasons that the corresponding statement with respect to claim 21 was clearly erroneous. Furthermore, it supports Applicant's position that the Examiner has failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.01. Ultimately, the Examiner has failed to establish any motivation to provide an identifier on or near a concrete memorial indicating that information related to the deceased person is available on an on-line registry service, as claimed in claim 43, and in combination with the other limitations recited in claim 43.

Conclusion:

Applicant notes that the dependent claims add other limitations that further distinguish over the cited references, providing additional bases for patentability. In view of the foregoing, Applicant respectfully requests that the Pre-Appeal Brief Conference Panel withdraw the Examiner's rejections of all of the claims on appeal, and that the pending claims be allowed in due course. Applicant reserves all rights and arguments with respect to those claimed features not expressly discussed above. Should this submission not comply with the submission requirements, or if the Panel has any outstanding issues to be addressed, the Applicant invites the Panel to contact the undersigned at (513) 369-4811, or at aulmer@fbtlaw.com.

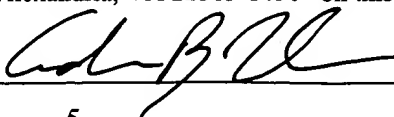
Respectfully Submitted,



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